

## **REMARKS/ARGUMENTS**

### **Amendments**

The specification is amended to correct the page numbering and several oversights that are grammatical, clerical or typographical in nature.

Claims 1-20 were pending. In this amendment, no claims have been amended or canceled. Thus, claims 1-20 will remain pending following this amendment.

### **Drawings**

Figs. 4, 7A, 9, and 12 have been amended in the interests of furthering prosecution. Redline versions of Figs. 7A and 12 are provided to accentuate the changes therein.

Fig. 4 has been modified to change the IP addresses and the domain names to artificial non-existent values.

Fig. 7A has been modified to add a "complete" box at the end of the "Yes" arrow.

Fig. 9 has been modified to change the IP addresses and the domain names to artificial non-existent values.

Fig. 12 has been modified to remove the arrow at the bottom of the box indicating step 1224.

A description of Fig. 5F is added to the detailed description section of the application in a manner fully supported by the drawing such that no new matter is added to the application.

### **35 U.S.C. §102 Rejection, Donaldson et al.**

The Examiner rejected claims 1-9, 11 and 13-16 under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,321,267 to Donaldson et al. (hereinafter "Donaldson"). Reconsideration in view of the following remarks is respectfully requested.

I. Claim 1-9

Donaldson fails to anticipate claims 1-9 because it fails to teach (or suggest) one or more elements of independent claim 1. For example, claim 1 recites, among other elements, "*checking for an open relay in routing information of a header of the electronic mail message.*" The Examiner asserts in the Office Action that Donaldson's active filtering (citing to column 8 lines 1-29 of Donaldson) anticipates the claimed checking for an open relay in routing information in claim 1. This rejection is respectfully traversed.

In col. 8 lines 10-14, Donaldson states the "Active Filter proxy probes the sending host at the time it connects and implements a series of tests to determine if the remote host is likely to be . . . an open relay (Active Relay testing)." From col. 14 line 60 to col. 15 line 40, Donaldson describes tests for determining an open relay, but none of these tests check routing information of a header of an electronic mail message, nor does Donaldson suggest doing so.

For at least the reasons stated above, Applicants submit that claim 1 is allowable over the cited references. As claim 1 is allowable, claims 2-10 dependent therefrom are also allowable for at least that reason.

Claim 4 depends from claim 1 and thus derives patentability therefrom. Claim 4 recites additional features that further distinguish over the cited references. For example, claim 4 recites, among other elements, "*baiting harvest of an electronic mail address corresponding the electronic mail message.*" The Examiner asserts in the Office Action that Donaldson's use of configuration databases (col. 11, lines 17-54) and Active User testing (col. 15, line 41 to col. 16, line 11) anticipate the claimed baiting harvest of an e-mail address. This rejection is respectfully traversed.

In col. 11, lines 17-54, Donaldson, describes using configuration databases, which are files that contain lists of networks, e-mail addresses, IP addresses, and other host information, in order to determine if the remote host "is likely to be a source of junk mail." There is no mention of a step of baiting harvest (by a spammer) of an electronic mail address to which the spammer may then send an electronic message.

In col. 15, line 41 to col. 16, line 11, Donaldson mentions Active User testing. The Active User testing identifies the mailhost for the supposed sender; and if it will not accept mail for the sender's address, the connection is terminated. See col. 15 lines 45-55. Donaldson's Active User test may close the connection for a bogus e-mail account used by a spammer, but does not employ a step of baiting harvest of an electronic mail address corresponding the electronic mail message.

For at least the reasons stated above, Applicants submit that claim 4 is allowable over the cited references. As claim 4 is allowable, claim 5 dependent therefrom is also allowable for at least that reason.

## II. Claims 11, 13-16

Donaldson fails to anticipate claims 11 and 13-16 because it fails to teach (or suggest) one or more elements of independent claim 11. For example, claim 1 recites, among other elements, "*checking for a source address in routing information of a header of the electronic mail message.*" The Examiner asserts in the Office Action that Donaldson's using configuration databases (col. 11, lines 17-54) and probing remote hosts (col. 14 lines 6-19) anticipate the claimed checking for a source address in routing information in claim 11. This rejection is respectfully traversed.

In col. 11, lines 17-54, Donaldson, discusses using configuration databases, which are files that contain lists of networks, e-mail addresses, IP addresses, and other host information, in order to determine if the remote host "is likely to be a source of junk mail." There is no mention of routing information of a header of an electronic mail message.

In col. 14 lines 6-19, Donaldson mentions "probing the remote host with a reverse SMTP connection to identify certain characteristics of the remote host." The IP address of the remote host is known via the initial TCP connection instituted by the remote host, and not from any analysis of the routing information of a header of an electronic message. See col. 14 lines 60-65. From col. 14 line 60 to col. 15 line 40, Donaldson describes tests for probing the remote hosts to identify certain characteristics, but none of these tests check routing information of a header of an electronic mail message.

In col. 14 lines 6-19, Donaldson mentions "probing the remote host with a reverse SMTP connection to identify certain characteristics of the remote host." The IP address of the remote host is known via the initial TCP connection instituted by the remote host, and not from any analysis of the routing information of a header of a message. See col. 14 lines 60-65.

In col. 15 lines 7-40, Donaldson describes tests for probing the remote hosts to identify certain characteristics, but none of these tests describe determining a facilitating party from the routing information of a header of a message.

For at least the reasons stated above, Applicants submit that claim 17 is allowable over the cited references. As claim 17 is allowable, claims 18-20 dependent therefrom are also allowable for at least that reason.

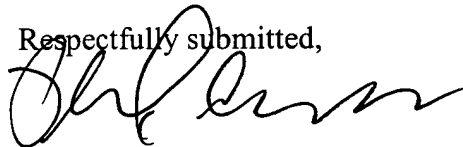
### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Dated: 7/22/04

Respectfully submitted,



Philip H. Albert  
Reg. No. 35,819

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
PHA:dbr:db

60266281 v1



(Annotated Sheet Showing Changes)

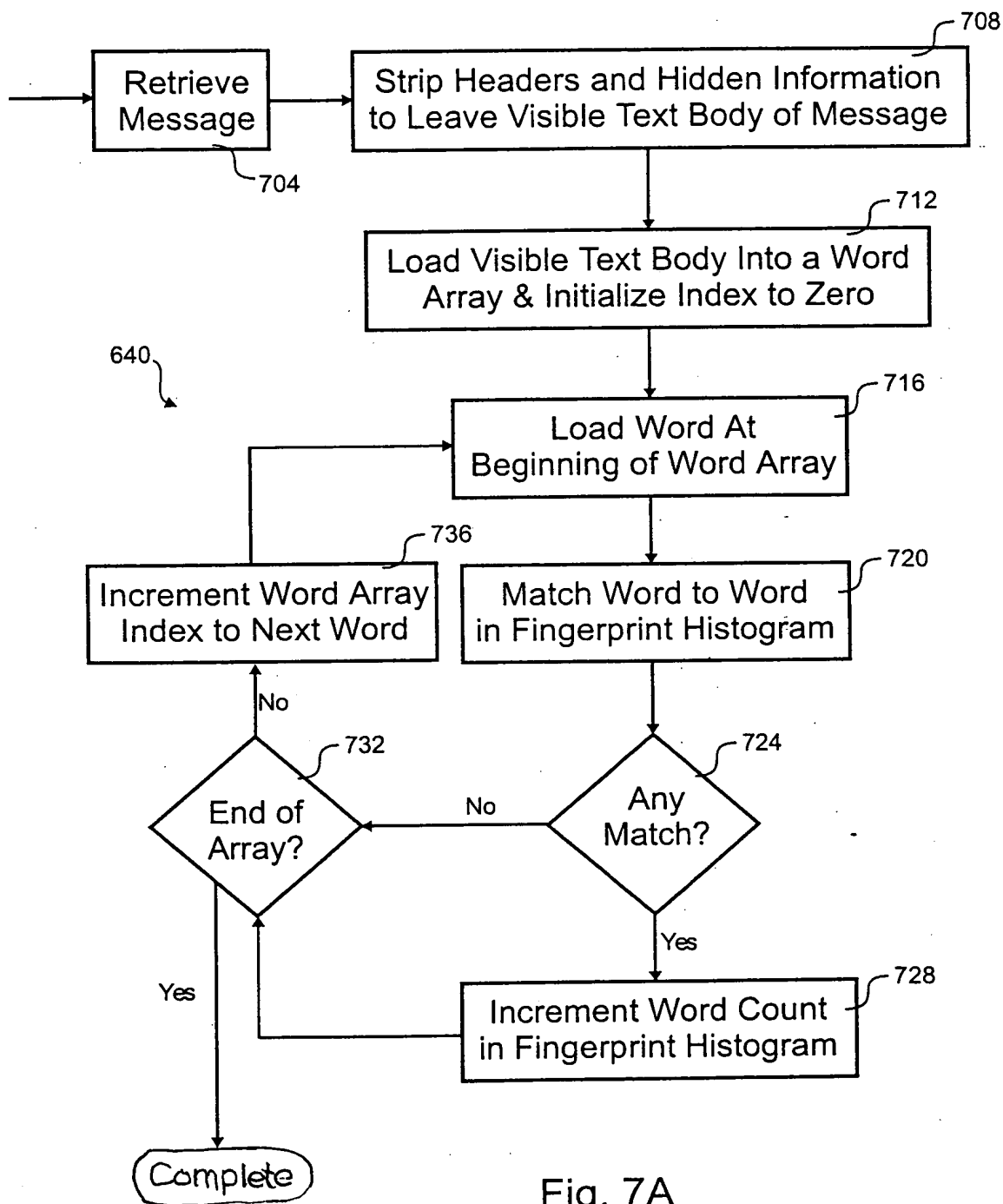


Fig. 7A



(Annotated Sheet Showing Changes)

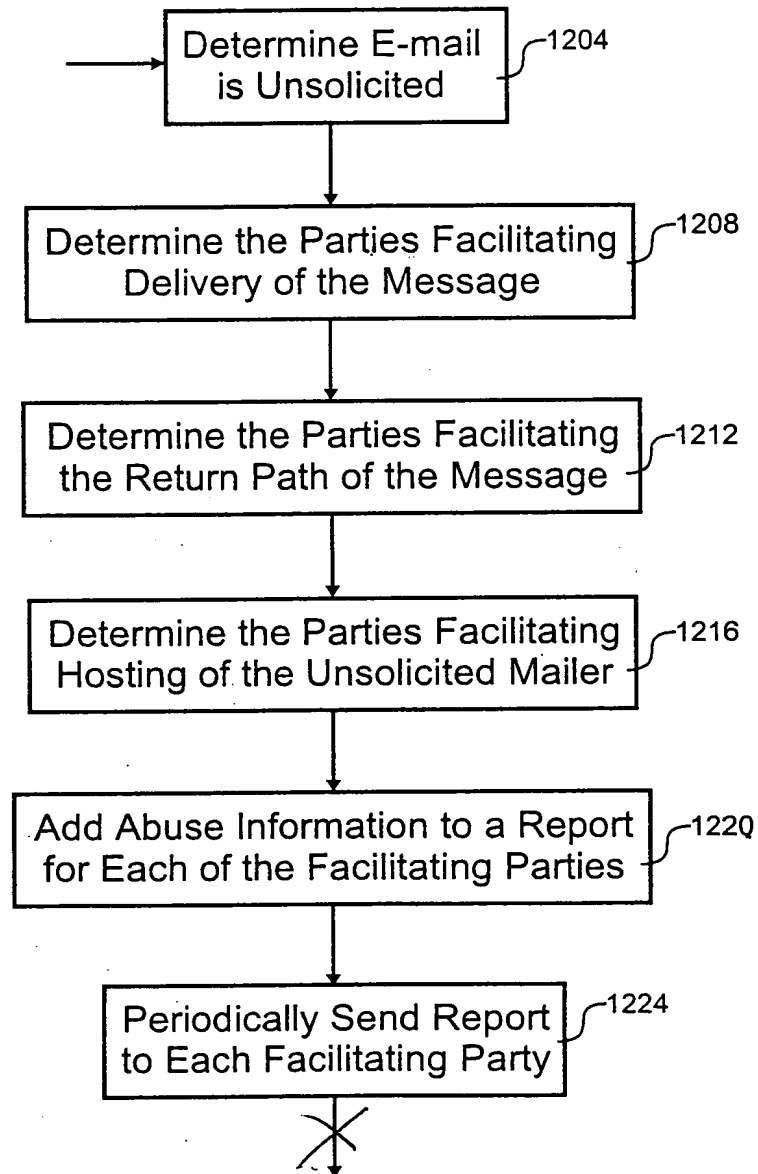


Fig. 12